Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MING JANG HWANG, KEIZO HOSODA,
SHINTARO AOYAMA, TADASHI TERASAKI
and TSUYOSHI TAMARU

Appeal No. 2002-2055
Application No. 09/727,547

ON BRIEF

Before COHEN, ABRAMS, and STAAB, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

The appellants have requested rehearing of our decision of June 18, 2003, (Paper No. 18) wherein we affirmed the examiner's rejection of claims 9-14.

DENIED.

BACKGROUND

The appellants' invention relates to a method of reducing by-product deposition inside wafer processing equipment. The examiner rejected claims 9, 11 and 14 under 35 U.S.C. § 102(e) as being anticipated by Comita et al. U.S. Patent Application Publication US2001/0008618A1 of July 19, 2001 (Comita), claims 9-12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Comita, and claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Comita in view of Nozaki et al. Japanese Kokai Patent Application SHO 61-117824 of June 5, 1986 (Nozaki).

The appellants did not traverse the rejections made by the examiner. Their sole argument was that Comita was not a proper reference because its effective filing date did not precede the filing date of their own U.S. Provisional Patent Application No. 60/070,697, which was filed on January 7, 1998, and which in their view established a constructive reduction to practice of the invention disclosed in the present application. However, Provisional Patent Application No. 60/070,697 became abandoned one year later by virtue of 35 U.S.C. § 111(b)(5), and therefore was not copending with the parent of the present application.

The appellants admitted that the present application was not entitled to the effective filing date of their provisional application, however, they argued that the provisional application "establishes a constructive reduction to practice or conception with diligence prior to the filing date of Comita," and therefore bars Comita from being

applied as a reference. They cited no legal precedent supporting this conclusion. We decided that the argument was contrary to 35 U.S.C. § 119(e)(1) and 35 U.S.C. § 120.

We have carefully reviewed the arguments presented in the Request for Rehearing, which can be summarized as follows: (1) "the properly filed provisional application is a constructive reduction to practice for all time, regardless of the abandonment thereof" (Request, page 2); (2) "there is nothing in the statute to later void such reduction to practice even though the provisional application be abandoned" (Request, page 3); and (3) this removes Comita as an available reference (Request, page 3). However, we are not persuaded that our decision was in error, and we shall not modify it.

Support for our conclusion is provided by our reviewing court in In re Costello and McClean, 717 F.2d1346, 1349, 219 USPQ 389 (Fed. Cir. 1983), which was cited by the examiner on page 8 of the Answer. The situation before the court was analogous to that before us, in that while the appellants did not satisfy the requirements of the Section 120, they still wished to eliminate a reference by virtue of a constructive reduction to practice based upon an earlier abandoned application. The Court makes the following statements, which support our conclusion in the instant case:

> Rule 131 requires proof of either "reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective filing date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application."

> Appellants' principal contention is that the filing of the later abandoned original application constitutes a constructive reduction to practice of the invention. Appellants cite no authority, nor can they, to support their argument. It has long been settled, and we continue to approve the rule, that an abandoned application, with which no subsequent application was copending, cannot be considered a constructive reduction to practice. It is inoperative for any purpose, save as evidence of conception.
>
> While the filing of the original application theoretically constituted a constructive reduction to practice at the time, the subsequent abandonment of that application also resulted in an abandonment of the benefit of that filing as a constructive reduction to practice. The filing of the original application is, however, evidence of conception of the invention. Appellants were able to reduce the invention to writing. That writing therefore constitutes documentary evidence that appellants had conceived the invention as of the filing date. As the Board found, however, appellants did not establish diligence in reducing the invention to practice. Appellants do not contest that finding. Thus the evidence is not sufficient to antedate Cereijo [the reference] under Rule 131.

(717 F.2d at 1349 and 1350, 219 USPQ at 391 and 392)

Application of the above reasoning by the court to the situation before us makes it clear that the failure on the part of the appellants to establish diligence over the period between the abandonment of the provisional application and the effective filing date of the present application allows Comita to stand as a reference against the claims.

While we have reconsidered our decision in the light of the arguments presented by the appellants in the Request for Rehearing, we have concluded that the decision should not be modified.

REQUEST FOR REHEARING DENIED

IRWIN CHARLES COHEN Administrative Patent Judge	)
NEAL E. ABRAMS Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
LAWRENCE J. STAAB Administrative Patent Judge	)

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APPEAL NO. 2002-2055 - JUDGE ABRAMS
APPLICATION NO. 09/727,547

APJ ABRAMS

APJ STAAB

APJ COHEN

DECISION: **REHEARING DENIED**

Prepared By: MURPHY

DRAFT TYPED: 21 Aug 03

FINAL TYPED: MURPHY